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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 529,722	04 19 2000	DAVID J SQUIRRELL	124-765	3335

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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11 15 2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/529,722

Applicant(s)

SQUIRRELL ET AL.

Examiner

David J. Steadman

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 August 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): previous rejections under 35 USC 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3 and 5-18.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other:

Continuation of 2. NOTE: Claims 19 and 27-29 require new rejections under 35 USC 112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: the amendment introduces new rejections under 35 USC 112, second paragraph and does not overcome the enablement rejection under 35 USC 112, first paragraph.

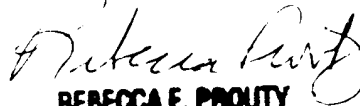
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### ADVISORY ACTION

1. Claims 1-3 and 5-18 are pending in the application.
2. The amendment has not been entered because said amendment raises new issues with regard to clarity and definiteness, thus requiring further consideration of the claims.
3. The request for reconsideration is acknowledged. While the amendment to the claims overcomes previous rejections under 35 USC 112, second paragraph, as set forth in Paper No. 11, the amendment to the claims does not place the claims in condition for allowance because the amendment would require new rejections under 35 USC 112, second paragraph, and for the reasons discussed below.
4. Applicants argue that the amendment to the claims overcomes the enablement rejection under 35 USC 112, first paragraph and therefore places the claims in condition for allowance. Applicants further argue that the present claims are drawn to enabled subject matter as set forth by the examiner in Paper No. 4. Applicants argue the examiner stated that the specification is enabled for "a method for producing and recovering luciferase that is substantially free of a mutant *Escherichia coli* adenylate kinase that is enzymatically inactive at temperatures greater than or equal to 37 °C" (page 6, Paper No. 4). However, in view of the non-entry of the amendments, this rejection is maintained for the reasons of record.
5. Applicant is advised that the amendment to the claims does not overcome the rejection under 35 USC 112, first paragraph as claims 19, 20, 23, and 25-32 are drawn to methods for producing and recovering luciferase that is substantially free of a mutant *Escherichia coli* adenylate kinase under temperature as well as *pH conditions*. As stated above, the specification is only enabled for "a method for producing and recovering luciferase that is substantially free of a mutant *Escherichia coli* adenylate kinase that is enzymatically inactive at temperatures greater than or equal to 37 °C" (page 6, Paper No. 4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:30 am to 2:00 pm and from 3:30 pm to 5:30 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
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*Rea*